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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,417	12/10/2003	Donald E. Kiely	UMT-105XC1	1170
46271	7590	07/13/2005	EXAMINER	
JEAN KYLE P. O. BOX 2274 HAMILTON, MT 59840-4274			ACQUAH, SAMUEL A	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/734,417

Applicant(s)

KIELY ET AL.

Examiner

SAMUEL A. ACQUAH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Applicants are hereby informed that the previously indicated allowability of claims 16, 17, 19, 20, 22, and 23 is now withdrawn in view of the following explanations.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Kiely et al '035.

The cited prior art is of record in the previous communication, and its disclosures are as discussed therein.

It is Applicant's position that this prior art is different because "The polymers produced by the cited prior method were not consistently stereoregular nor were they of a molecular weight to classify them as high polymers... Therefore, the method of the subject invention requires that esterification be conducted under conditions that limit alcoholysis of the amide bond. ***Controlling these conditions leads to more consistent esterified amidoamino acids which leads to more consistent stereoregular polymers (step b)... The cited reference does not require step (a) be conducted under conditions that limit alcoholysis of the amide bond nor does the reference describe further polymerizing formed prepolymers (step c) into high molecular weight postpolymers.***" (emphasis added).

It is the Examiner's position that Applicants' arguments are not convincing. First of all, it is noted that while the cited prior art does not specifically indicate that step a) be conducted under conditions as claimed and argued above, the claim merely recites that

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the step be conducted under conditions that limit alcoholysis of the amide bond. Infact, the claim does not indicate what those conditions are. It is noted from Applicants' arguments that the gist of Applicants' process claim is in the step b) wherein Applicants' argue that **"Controlling these conditions leads to more consistent esterified amidoamino acids which leads to more consistent stereoregular polymers"**. Also, note Applicants' argument above that **"the polymers produced by the cited prior method were not consistently stereoregular"** (emphasis added). In essence, it is step b), according to Applicants' argument, that really distinguishes the claims from those of the prior art. Thus, the question is whether the cited prior art discloses step b). The answer is obviously "yes", and in this regard, attention is hereby directed to the various Examples 9-14. All of those Examples disclose the preparation of head, tail-poly(alkylene D-glucaramide) having the chemical formulas as claimed herein in claims 8-12, 15, 18, and 21. These Examples all show polymerizing the esterified amidoamino acid in a protic solvent in the presence of a tertiary amine to form a prepolymers which are further polymerized to solid products having high melting points in excess of 180 degrees C. These polymers are useful in making films and other industrial products of high molecular weight. See column 4, line 30 et seq. It is the Examiner's position that the claims herein are not patentably distinct, and Applicants' arguments do not distinguish them from those of the cited prior art.

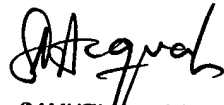
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMUEL A. ACQUAH whose telephone number is 571-272-1065. The examiner can normally be reached on M-TH, FRIDAYS OFF.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES SEIDLECK can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.A.A.  
07/10/05

  
SAMUEL A. ACQUAH  
PRIMARY EXAMINER  
GROUP ~~1200~~ 1700